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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 12

Application Number: 09/406,381
Filing Date: September 27, 1999
Appellant(s): CHEBROLU, PRASAD Y.

Kurt M. Pankratz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 5, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The claims are grouped by Appellants as follow:

Group I. Claims 10 and 28 stand or fall together.

Group IIA. Claims 1, 7-9, 16-19, 25-27 and 34-36 stand or fall together.

Group IIB. Claims 3-5, 12-14, 21-23 and 30-32 stand or fall together.

Group IIC. Claims 6, 15, 24 and 33 stand or fall together.

Group III. Claims 2, 11, 20 and 29 stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,546,379	Thaweethai et al.	08-1996
5,828,583	Bush et al.	10-1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

A. Claims 10 and 28 stand rejected under 35 U.S.C. 102(b) as being clearly anticipated by Thaweethai.

Reference is made to Figure 5 and the description in columns 16-20 and the claims in Thaweethai. Thaweethai teaches:

Claims 10 and 28 . A method of selecting a modem for service, comprising:

storing a performance attribute for each of a plurality of modem (see "storage means" and "capability interpretation means" at the top right corner of Figure 5);

receiving a modem request (see "modem requirements defined and input by user" in Figure 5);

selecting a modem for service according to the modem's performance attribute (see selection means" in Figure 5); and

coupling a remote modem and the selected modem (see "remote modem, connection means, and modems 1-n" in Figure 5.

B. Claims 1, 3-9, 12-19, 21-27 and 30-36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Thaweethai.

Reference is made to Figure 5 and the description in columns 16-20, 65 and the claims in Thaweethai and also MPEP section 2114 for apparatus claims. Thaweethai teaches:

Claim 1 as an exemplary: an access server (Figure 5 and lines 1-29 of column 65 in Thaweethai), comprising:

a plurality of modems (modems 1-n in Figure 5);

a memory (see "storage means" at the top right corner of Figure 5) operable to store a performance attribute for each modem;

an allocation module (see "capability interpretation means" and "selection means" in Figure 5) coupled to the memory and operable to receive a modem request (see "modem requirements defined and input by user" in Figure 5) and to select a modem for service according to the modem's performance attribute; and

a telecommunications interface (see "connection means" in Figure 5) coupled to the allocation module and operable to couple a remote modem (see "remote modem" in Figure 5) to the selected modem.

The only difference is that Thaweethai does not characterize the apparatus as a server. The position of the Examiner is that label of an apparatus is not a patentable subject matter. It is well known that server is implemented by computer system. Further, since Thaweethai meets all the limitations recited in the claim combination, it is qualified to label the system of Thaweethai as an access server.

With respect to **claim 3**, Thaweethai teaches: the access server of claim 1, wherein:

the memory is further operable to store a plurality of user profiles (see lines 57-67 of column 18 in Thaweethai, user profiles read on "user defined tag which is specified in the modem characteristics record" in Thaweethai); and

the allocation module is further operable to receive a user identifier (inherent, the Examiner will explain in "Response to the Arguments" below.) associated with the modem request ("modem requirements defined and input by user" in Figure 5), to identify a user profile (user defined tag in lines 57-67 of column 18) associated with the user identifier in the momory ("storage means" in Figure 5), and to select a modem ("selection means" in Figure 5) for service according to the modem's performance attribute and the user profile.

With respect to **claim 6**, Thaweethai did not explicitly teach that modem is removed from service if it is out of service (fail to function properly). This feature is inherent in a modem pool system such as Thaweethai's. Figure 5 of Thaweethai shows that all the modems are arranged in parallel. If a modem fails to operate, no selection will be made to the failed modem. The defective modem in effect is removed out of service if it is never selected. Further, it would have been obvious to a person of ordinary skill in the art to remove a defective modem from service because no connection can be made by the defective modem.

C. Claims 2, 11, 20 and 29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Thaweethai in view of Bush.

With respect to **claim 2** for exemplary, Thaweethai teaches claim combination set forth in the rejections above. Updating performance attributes of an apparatus being monitored is well known in the art. Bush teaches updating of performance attributes of a disk drive being monitored. Reference is made to lines 17-24 and lines 40-51 of column 38 and claims 17 and 21 in Bush. From the teaching of Bush, it would have been obvious to a person of ordinary skill in the art to update the performance attributes of Thaweethai such that the stored attributes reflect the latest data as suggested by Thaweethai in lines 52-57 of column 2, line 50-51 of column 3. In the excerpts identified, Thaweethai teaches that all connections to the selected modems are monitored. Obviously, the monitoring is for collecting information and the collected information is for updating the stored information as taught by Bush.

(11) Response to Argument

I. Arguments directed to claims 10 and 28 (Group I) on pages 4-8 of Appellants' Brief. Claims 10 and 28 stand or fall together.

On page 5, Appellants alleged that Thaweethai fails to anticipate every element of claim10. However, Appellants fail to identify one single element of claims 10 and 28 which Thaweethai does not have. The fact is, Thaweethai has every element of claims 10 and 28. There is no obviousness. No obvious modification can be made to Thaweethai because Thaweethai has every element of claims 10 and 28. Appellants' entire patentability argument rests on the difference between the definition of Appellants' "modem performance attributes" and the definition of Thaweethai's "modem characteristics".

Appellants contended that modem characteristics disclosed by Thaweethai are predetermined, and not based on performance. The Examiner disagrees. Firstly, the claims did not recited that the modems are selected based on performance. Rather, the claims recite that the modems are selected based on **stored** performance **attributes.** In other words similar to Thaweethai, Appellants' selection of modems is **based on predetermined, pre-stored information.** The claims did not recite that the modems are dynamically monitored for performance attributes and the selection is based on the dynamically collected performance attributes. Contrarily to Appellants' allegation, Thaweethai's selection of modem is based on both pre-stored information and dynamically generated performance information. Thaweethai teaches that all modems are monitored (see lines 49-50 of column 3). See also Thaweethai's abstract. Thaweethai teaches that modems are selected based on network demand, throughput and delay requirements, distribution of network load over multiple connections. All the above techniques inherently require dynamically generated performance data. Secondly, Appellants' performance attributes are subsets of Theweethai's modem characteristics and both are pre-stored and predetermined.

IIA. Arguments directed to claims 1, 7-9, 16-19, 25-27 and 34-36 (Group IIA) on Pages 8-9 of Appellants' Brief. Claims 1, 7-9, 16-19, 25-27 and 34-36 are further grouped by the Examiner into apparatus claims 1, 7-9, 19 and 25-27 and method claims 16-18 and 34-36. The apparatus group falls but not stand with the method group (MPEP 2114).

Both Appellants and the Examiner rely on the arguments presented in the paragraph above for support of their positions in the rejection of claims 1, 7-9, 16-19, 25-27 and 34-36. Since claims 10 and 28 are method, method claims 16-18 and 34-36 therefore stand or fall together with claims 10 and 28. Apparatus claims 1, 7-9, 19 and 25-27 fall with claims 10 and 28 but do not stand with them for the following reasons.

Further with respect to the apparatus claims 1, 7-9, 19 and 25-27, reference is made to MPEP section 2114. The section requires that apparatus claims must be structurally distinguishable from the prior art. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*; 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is , and not what a device does." *Hewlett-Packard Co. v. Bausch $ Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham,* 2 USPQ2d 1647 (Bd. Pat. App & Inter. 1987).

The Thweethai reference clearly teaches all the structural limitations of the claims as set forth in the rejections above. Appellants fail to point out one element which is not in Thaweethai.

IIB. Arguments directed to claims 3-5, 12-14, 21-23 and 30-32 on pages 9-11 of Appellants' Brief. Claims 3-5, 12-14, 21-23 and 30-32 stand or fall together.

In lines 20-21 of page 10 of Appellants' brief, it appears that Appellants probably meant "storing ... a plurality of user profiles" rather than "storing...a plurality of modem capability parameters".

Appellants contended that Thaweethai does not have a user profile stored in the memory and does not have a user ID for identifying the user profile in selection of modem for connection. The Examiner disagrees. Thaweethai clearly teaches user defined tag (user profile) stored in the memory along with modem characteristics (or modem capability parameters used in Thaweethai's claims) in lines 57-67 of column 18. As to user ID, it is inherent. The user ID is recited in Appellants' claims for identifying the user profile stored in the memory. Since Thaweethai's tags and modem characteristics are stored in a memory and the memory is accessed in response to user inputted information, the user inputted information must includes information for accessing the memory. The access information (the address used to access memory) inputted by the user of Thaweethai reads on Appellant's user ID.

IIC. Arguments directed to claims 6, 15, 24 and 33 on pages 11-12 of Appellants' Brief. Claims 6, 15, 24 and 33 stand or fall together.

Reference is made to the rejection of claim 6 above. Removing an out of service modem from the pool is inherent in the system of Thaweethai. If the pre-stored and predetermined information in the memory of Thaweethai indicates that the modem is out of service, the modem would never be selected. The defective modem in effect is removed out of service if it is never selected. Further, it would have been obvious to a

person of ordinary skill in the art to remove a defective modem from service because no connection can be made by the defective modem.

III. Arguments directed to claims 2, 11, 20 and 29 on pages 12-14 of Appellants' Brief. Claims 2, 11, 20 and 29 stand or fall together.

Reference is made to the rejection of claim 2 above. Claim 2 requires 1. an act of monitoring, 2. for monitoring the selected modem's performance, and 3. to modify the performance attribution in accordance with monitoring. The abstract of Thaweethai teaches that the selection of modem is based on information such as network demand, throughput, delay requirement and distribution of network load (load balance), etc. Part of the information is predetermined and pre-stored. The rest of the information is obtained through dynamic monitoring (dynamic, not pre-stored, performance attributes). Thaweethai clearly teaches monitoring of all connections to the remote network in lines 50-51 of column 3. See also lines 53-57 of column 2. Modem responses clearly are obtained form monitoring. Thaweethai alone at least meets the limitations of 1 and 2. The Examiner relies on Bush for the teaching of updating. As set forth in the rejection, Bush teaches updating of performance attributes. Since Thaweethai relies on pre-stored and predetermined performance parameters for selection and the obtained information through monitoring is performance parameters, it would have been notoriously obvious to a person of ordinary skill in the art to update the stored parameters as taught by Bush such that the selected modem is better match to the user's requirements.

For the above reasons, it is clear that Thaweethai alone or in combination with Bush meets all the structural and method step limitations of the claims. It is submitted

that the Final Rejection remains intact. Accordingly, it is respectfully requested that the Final Rejection be sustained.

Respectfully submitted,

David Y. Eng

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PRIMARY EXAMINER

March 5, 2004

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